

REMARKS

Claims 1-28 are pending. Of these, claims 1, 8, 15 and 22 are written in independent format.

SPECIFICATION OBJECTION

The abstract of the disclosure is objected to because the abstract is not in a single paragraph of 150 words or less. By this reply, Applicant has submitted a replacement abstract. Accordingly, withdrawal of the objection is requested.

CLAIM OBJECTIONS

Claims 7, 14, 21 and 28 are objected to because of minor informalities. The Examiner has suggested clarifications that would overcome the objection. Applicant thanks the Examiner for the suggestions. By this reply, Applicant has made the clarifying changes suggested by the Examiner. Accordingly, withdrawal of the objection is requested.

§ 101 REJECTION

Beginning on page 2 of the Office Action, claims 22-28 stand rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. This rejection is traversed.

In his rejection rationale, the Examiner has cited no authority to support the proposition that propagated signals represent non-statutory subject matter. Applicant infers for the sake of discussion that the Examiner has relied upon page 57 (of 59) of the "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (OG Notices 22 November 2005¹).

The Examiner is reminded that Interim Guidelines merely "propose that such signal claims are ineligible for patent protection because they do not fall within any of

¹ See <http://www.uspto.gov/web/offices/com/sol/og/2005/week47/patgupa.htm>.

the four statutory classes of § 101"; see page 57 of 59. A "proposal" is not a law under 35 U.S.C., nor is it a Rule under 37 C.F.R., nor does the proposal itself cite any case law for a holding that propagated signals are non-statutory.

Until the Examiner provides cites authority that reasonably supports the grounds of his rejection, he has not met his burden of providing evidence in support of the rejection. Without such evidence, the rejection is arbitrary and capricious, and as such denies Applicant Procedural Due Process.

Accordingly, withdrawal of the rejection is requested. If the Examiner wishes to maintain the rejection, Applicant submits that a succeeding Office Action (which maintains the rejection and includes reasonable citation to authority) must be a non-final Office Action.

§ 112 REJECTION

Beginning on page 3 of the Office Action, claims 4, 11 and 25 stand rejected under 35 U.S.C. §112, second paragraph; in particular, the Examiner criticizes the claims as having insufficient antecedent basis for the limitation "the sending" of the claims. This rejection is traversed.

By this reply, a clarifying amendment has been made to each of claims 4, 11 and 25 that should address the Examiner's criticism. Accordingly, withdrawal of the rejection is requested.

§ 102 REJECTION – GUPTON '291 PGPUB

Beginning on page 4 of the Office Action, claims 1-4, 6-11, 13-17, 20-25, 27 and 28 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Pre-Grant Publication ("PGPub") No. 2004/0255291 to Gupton et al. ("the Gupton '291 PGPub"). This rejection is traversed.

The Gupton '291 PGPub is generally directed to a system for installing, updating or removing software applications onto/on/from on a given machine that takes into

account various dependencies and inter-relatedness of software applications on the given machine; see Paragraph ("PGH") 25. Such a system includes a test executive engine 220 that manages test engine sequences; see PGH 106.

Test executive engine 220 is specialized software that allows a user to organize and execute sequences of reusable test modules to test units under test ("UUTs"); see PGH 5. For example, the test modules may interact with one or more hardware instruments to test the UUT(s); see PGH 5. Text executive software typically includes various features, such as test sequencing based on pass/fail results, logging of test results, and report generation, among others; see PGH 5.

A test executive sequence is series of steps that a user specifies for execution in a particular order; see PGH 11. A step is an action that the user can include within a sequence of other actions; see PGH 9. A step may call a test module to perform a specific test; see PGHs 9 and 106. Not all steps necessarily call a module; see PGH 112.

Whether and when a step is executed can depend on the results of previous steps; see PGH 11. In other words, not all steps in a test executive sequence are necessarily executed; see PGH 112. For example, the user may configure some steps to be skipped, e.g., depending on execution results of previous steps; see PGH 112.

Results of the execution of a step may be collected and stored; see PGH 112. The Gupton '291 PGPub mentions nothing regarding any sort of manipulation of the results of a step.

A distinction over the Gupton '291 PGPub of claim 1 is administering a sequence of test-modules, there being at least one rule of which at least one of the test-modules is the subject, each rule including one or more actions conditioned upon the distilled result returned by the corresponding test-module, wherein a given distilled result is based upon intermediate results generated by at least one software-targeted inquiry included in a given test-module. While the Gupton '291 PGPub discloses that a step in a test executive sequence might be skipped based upon results of another step, the

Gupton '291 PGPub discloses nothing regarding manipulation of the results of a step, much less distillation of intermediate results into a distilled result upon which a conditional action is evaluated.

Independent claims 8, 15 and 22 recite features similar to the noted distinction of claim 1, respectively, and thus at least similarly distinguish over the Gupton '291 PGPub.

Claims 2-4, 6-7, 9-11, 13-14, 16-17, 20-21, 23-25, 27 and 28 depend at least indirectly from claims 1, 8, 15 and 22, respectively, and thus at least similarly distinguish over the Gupton '291 PGPub.

By failing to disclose each element of the rejected claims, the Gupton '291 PGPub cannot be regarded as anticipatory. Hence, the §102(e) rejection is improper and its withdrawal is requested.

§ 103 REJECTION – GUPTON '291 PGPUB + KERR '658 PATENT

Beginning on page 16 of the Office Action, claims 5, 12, 19 and 26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the Gupton '291 PGPub in view of U.S. Patent No. 5,220,658 to Kerr et al. ("the Kerr '658 patent"). This rejection is traversed.

Applicant will assume for the sake of argument that some portion of the Gupton '291 PGPub would have been modified according to some portion of the Kerr '658 patent.

Claims 5, 12, 19 and 26 depend at least indirectly from claims 1, 8, 15 and 22, respectively, and thus at least similarly distinguish over the Gupton '291 PGPub; see the traversal above of the §102 rejection. Nothing about the Examiner's obviousness rationale vis-à-vis the Kerr '658 patent addresses the respective noted distinctions of claims 1, 8, 15 and 22.

By failing to disclose each element of the rejected claims, a combination of the Gupton '291 PGPub and the Kerr '658 patent cannot be regarded as a proper basis for

an obviousness rationale. Hence, the §103(a) rejection is improper and its withdrawal is requested.

§ 103 REJECTION – '139 PATENT

Beginning on page 17 of the Office Action, claim 18 stands rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent no. 6,988,139 to Jervis et al. ("the Jervis '139 patent"). This rejection is traversed.

Applicant will assume for the sake of argument that some portion of the Gupton '291 PGPub would have been modified according to some portion of the Jervis '139 patent.

Claim 17 depends from claim 15 and thus at least similarly distinguishes over the Gupton '291 PGPub; see the traversal above of the §102 rejection. Nothing about the Examiner's obviousness rationale vis-à-vis Jervis '139 patent addresses the noted distinction of claim 1.

By failing to disclose each element of the rejected claims, a combination of the Gupton '291 PGPub and the Jervis '139 patent cannot be regarded as a proper basis for an obviousness rationale. Hence, the §103(a) rejection is improper and its withdrawal is requested.

<remainder of page intentionally left blank>

CONCLUSION

The issues raised in the Office Action are considered to be resolved. Accordingly, Applicant again requests a Notice of Allowance.

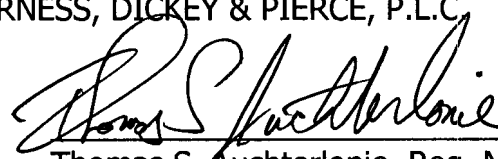
If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact the undersigned.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge any underpayment or non-payment of any fees required under 37 C.F.R. §§ 1.16 or 1.17, or credit any overpayment of such fees, to Deposit Account No. 08-2025, including, in particular, extension of time fees.

Respectfully submitted,

HARNESS, DICKEY & PIERCE, P.L.C.

By:



Thomas S. Auchterlonie, Reg. No. 37,275

P.O. Box 8910

Reston, VA 20195

(703) 668-8000

TSA/cm:tsa